

REMARKS

The Examiner has required Applicant to restrict this application to one of the following inventions with additional elections required:

- Group I. Claims 1-221, directed to the details of first type of detecting device (identification mark means is on a rotating shaft); or
- Group II. Claims 222-247, directed to the details of second type of detecting device (sensing device is on a rotating shaft).

Applicant hereby elects Species Ia-1-1, a first type of identification means, and believes that claims 7-14/5, 179-181, 192-193/180 are readable thereon. Applicant also believes that claims 1-5, 178, 192-193/178, and 200 are also readable on the elected species. This election is made with traverse. Applicant reserves the right to submit any Divisional patent applications directed toward the non-selected invention.

In response to the outstanding Office Action, Applicant has made a provisional election of one species (Species Ia-1-1) for prosecution with traverse.

With respect to the Examiner's requirement for election of species and the reasons provided therefore, Applicant respectfully disagrees for the reasons given below.

Firstly, the Examiner's reasons for restriction are not commensurate with the scope of claims in the various groups. The Examiner states that the present application contains claims directed to two distinct species (Groups I and II), and further identifies Group I (claims 1-221) as being directed to a first type of a detecting device with identification mark means on a rotating shaft. However, a review of claims 1-221 of Group I reveals that this is not true. Specifically,

independent claim 1 claims a detecting device comprising "a light source, an identification mark means, and a sensor for detecting the light beams emitted by the light source and coming from the identification marks means." Clearly, there is no limitation in claim 1 reciting that the identification mark means is on a rotating shaft. Accordingly, the reasons for such a restriction are incorrect.

Secondly, the Examiner's reasons for restriction are not based upon application of the criteria specified in MPEP §806, respecting election of species and restriction requirements.

Pursuant to MPEP § 806.04(f), claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species. However, a thorough reading of the disclosure and the claims of the alleged Groups I and II shows that the two groups of claims are not mutually exclusive and can read on the same embodiments which are illustrated in the drawings as Figs. 16 (the tenth embodiment), 17 (the eleventh embodiment), 18 (the twelfth embodiment), 19 (the thirteenth embodiment), and 22 (the sixteenth embodiment). Also see *Ex parte Muench*, 79 USPQ 92, 93 (BOPA 1948), "Mutual exclusiveness is one of the commonly used tests of species... We are of the opinion that in addition to the test of exclusiveness the disclosure must be considered, and that the fact alone that the claims are not mutually exclusive does not avail unless there is a disclosure of a

single embodiment on which both sets of claims will read, which, in the present type of case, should be a specific example. Stated otherwise, neither of the sets of claims could be amended to include matter from the other without introducing new matter and hence the two sets are mutually exclusive. Accordingly, the Examiner's reasons for such a restriction requirement do not stand.

Lastly, no serious burden exists on the Examiner in examining both Groups I and II of the claims. MPEP § 803 specifies that the two criteria for a proper requirement for restriction between patentably distinct inventions are: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is required. However, the limitations distinguishing claims of Group I from claims of Group II in fact appear in dependent claims of Group II, and vice versa. Various exemplary claims can be correspondingly found in the two groups, and thus a detailed listing is herein omitted. Accordingly, there is no serious burden existing since the Examiner need not have to search the prior art for the same limitations defining the first group when examining claims in the second group.

For the reasons stated above, reconsideration and withdrawal of the restriction requirement are respectfully requested.


Application No. 10/786,028

An early action on the merits of this application is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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